

REMARKS

Claims 1-48 were pending as of the action mailed on September 22, 2006. Claims 1, 15, 18, 20, 26, 40, and 43 are in independent form.

Claims 1, 20, 26, and 43 are being amended. No new matter has been added.

Reexamination and reconsideration of the action are requested in light of the foregoing amendments and the following remarks.

**Section 102**

Claims 1-7, 18, 20, 26-32 and 43 were rejected as allegedly anticipated by U.S. Patent No. 6,959,382 ("Kinnis").

Claim 1. The examiner rejected claim 1 stating that:

Kinnis discloses a computer implemented method, comprising:

accessing an electronic document using a user application, the electronic document including a digital signature module, the digital signature module being operable to perform digital signature operations on the electronic document (Column 2: lines 40-56; Column 5: lines 5-15,55-67; Figure 5: 520, 10; Figure 9: 910, 925, 930, 935); and

using the digital signature module to perform one or more digital signature operations on the electronic document in the user application (Column 10: lines 27-58; Figure 9: 975, 945).

Kinnis teaches a digital signature service that operates in one of two configurations: "The digital signature service may operate as a client application program on a user's computer, or may operate as a server application, over a network." Kinnis, col. 4: lines 2-4. This does not meet the limitations of the claim. The claim recites an "electronic document including a digital signature module." In other words, the digital signature module is included in the electronic document.

In the first configuration, the digital signature service 100 runs as a client application on a computer. The digital signature service may be downloaded from a signature agent via a signature agent website. Kinnis, col. 4: lines 2-11, Fig. 1. The digital signature service 100, in

this configuration, is independent of and not included in, attached to, contained in, or embedded in the electronic document 150. Kinnis, Fig 1.

In the second configuration, the digital signature service 100 runs as a web-based server application which is accessed over a network and operates as part of a repository for digitally signed documents. Kinnis, col. 4: lines 2-4, 40-47, col. 5: lines 16-18, Fig. 2. The digital signature service 100, in this configuration, is also independent of and not included in, attached to, contained in, or embedded in the electronic document 150. Kinnis, Fig. 2.

The two configurations Kinnis teaches for the digital signature service differ from what is recited in the claims, namely that the digital signature module is included in the document. The specification teaches that this can occur in various ways: “the electronic document *includes* a digital signature module,” “*embedding* a digital signature module in an electronic document,” “the self-signing electronic document *containing* . . . a digital signature module,” an electronic document with an “*attached* digital signature module.” Specification, page 2: line 6; page 3: line 8; page 9: lines 23-24; page 10: line 25. This is further shown in the figures. See Fig. 1A; Fig. 3; Fig. 4. Unlike the signature service of Kinnis, the claimed digital signature module does not exist independently of the electronic document on which the digital signature operations are being performed.

Furthermore, as the examiner later acknowledges in the rejection of claim 15, “Kinnis does not explicitly disclose embedding a digital signature module in an electronic document, the digital signature module being operable to perform one or more digital signature operations on the electronic document.” In fact, Kinnis does not teach creating any kind of association as a result of which the digital signature module would be tied to the document.

For at least these reasons, the rejection of claim 1 should be withdrawn.

Claim 18. The examiner rejected claim 18 stating that “Kinnis discloses a method, a electronic document, comprising: . . . a digital signature module . . . (Column 2: lines 40-56; Column 5: lines 5-15,55-67; Figure 5: 520, 10; Figure 9: 910, 925, 930, 935; Column 10: lines 27-58; Figure 9: 975, 945).”

The applicant disagrees.

The passages and figures cited by the examiner are the same as those the examiner cited as a basis for rejecting claim 1.

As explained above in reference to claim 1, Kinnis does not teach an “electronic document, comprising: . . . a digital signature module” that can perform digital signature operations on the document, which is what is recited in claim 18.

Therefore, for at least this reason, the rejection of claim 18 should be withdrawn.

Claim 20. The examiner rejected claim 20 stating that:

Kinnis discloses a computer implemented method, comprising:  
receiving a signed electronic document, the electronic document including a digital signature module and a digital signature generated by the digital signature module, the digital signature module being operable to perform digital signature operations on the electronic document (Figure 3; 140, 100, 140, 150, 700; Figure 9: 900; Column 9: lines 13-30);  
accessing the electronic document in a user application (Figure 3; 140, 100, 140, 150, 700; Figure 9: 900; Column 9: lines 13-30); and  
validating the digital signature using the digital signature module in the user application. (Figure 3; 140, 100, 140, 150, 700; Figure 9: 900; Column 9: lines 37-64).

The applicant disagrees. The passages and figures cited by the examiner actually show the difference between Kinnis and what is claimed.

Kinnis states that “the digital signature service 100 generates the signature file 140. The signature file 140 includes a document(s) 150, certificate 160, and signature 145.” Kinnis, col. 5: lines 56-59. Rather than being included in the electronic document, Kinnis’s digital signature service actually *generates* the signature file that *contains* the electronic document. The signature file of Kinnis does not *include* the digital signature module recited in the claim.

Kinnis’s digital signature service is independent of and not included in, attached to, contained in, or embedded in the electronic document. Therefore, Kinnis does not meet the limitations of the claim.

The rejection of claim 20 should be withdrawn, therefore, for substantially the same reasons that apply to claim 1.

Claim 26. Claim 26 was rejected as being substantially similar to claim 1. The rejection of claim 26 should be withdrawn, therefore, for the same reasons that apply to claim 1.

Claim 43. Claim 43 was rejected as being substantially similar to claim 20. The rejection of claim 43 should be withdrawn, therefore, for the same reasons that apply to claim 20.

### **Section 103**

Claims 15, 16, 21, 22, 40, 41, 44 and 45 were rejected as allegedly unpatentable over Kinnis in view of U.S. Patent Application Publication US2002/0112162 (“Cocotis”).

Claim 15. The examiner rejected claim 15 stating that

Cocotis, in analogous art, however, disclose embedding a digital signature module in an electronic document, the digital signature module being operable to perform one or more digital signature operations on the electronic document (Page 5: 0048; Page 5: 0049, 61, 67).

The applicant disagrees.

The passages cited by the examiner describe an embedded public key, not an embedded digital signature module that can perform digital signature operations, as recited in the claim.

Claim 40. Claim 40 was rejected as being substantially similar to claim 15. The rejection of claim 40 should be withdrawn, therefore, for the same reasons that apply to claim 15.

### **Drawings**

The applicant respectfully request that the examiner indicate that the drawings filed on September 4, 2003, are acceptable.

### Conclusion

All the claims that have not been addressed explicitly depend from claims that have been addressed, and are allowable for at least the reasons set forth in reference to those claims.

For the foregoing reasons, the applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

  
\_\_\_\_\_  
Hans R. Troesch  
Reg. No. 36,950

Date: 22 Dec 06  
Customer No. 021876  
Telephone: (650) 839-5070  
Facsimile: (650) 839-5071